



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,878	08/23/2001	Hidetaka Magoshi	SCEA 3.0-003	1362

530 7590 01/27/2006

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER

MEONSKE, TONIA L

ART UNIT	PAPER NUMBER
----------	--------------

2181

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/935,878	Applicant(s) MAGOSHI, HIDETAKA	
	Examiner Tonia L. Meonske	Art Unit 2181	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-25 and 31-35 is/are allowed.
- 6) ☒ Claim(s) 1-22, 26-30, 36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4, 5, 9-11, 26-30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Blomgren et al., US Patent 5,781,750, cited by Applicant on the Information Disclosure Statement filed on January 13, 2003.

3. The rejections are respectfully maintained and incorporated by reference as set forth in the office action mailed on January 12, 2005.

4. Claims 36 and 37 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Blomgren et al., US Patent 5,781,750, cited by Applicant on the Information Disclosure Statement filed on January 13, 2003.

5. The rejections are respectfully maintained and incorporated by reference as set forth in the office action mailed on June 27, 2005.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2181

7. Claims 15-22, are rejected under 35 U.S.C. 103(a) as being obvious over Blomgren et al., US Patent 5,781,750, cited by Applicant on the Information Disclosure Statement filed on January 13, 2003, in view of Hennessy. Claim 15 has been amended to include the limitation “providing both the computer instruction and the jump instruction”. Blomgren has taught providing both the computer instruction (directly supported instructions) and the jump instruction (emulated instructions) (Figure 2, element 46, column 6, lines 53-56, elements 42 and 38, column 6, lines 28-32, column 7, lines 1-12 and 25-67, column 9, lines 1-32 and 45-54).
8. Claims 6, 7, 8, 12, 13, and 14 are rejected under 35 U.S.C. 103(a) as being obvious over Blomgren et al., US Patent 5,781,750, cited by Applicant on the Information Disclosure Statement filed on January 13, 2003.
9. Claim 3 is rejected under 35 U.S.C. 103(a) as being obvious over Blomgren et al., US Patent 5,781,750, in view of Ireton, US Patent 5,826,089, both cited by Applicant on the Information Disclosure Statement filed on January 13, 2003.
10. The rejections are respectfully maintained and incorporated by reference as set forth in the last office action mailed on January 12, 2005.

Allowable Subject Matter

11. Claims 23-25 and 31-35 are allowed.

Response to Arguments

12. Applicant's arguments filed October 31, 2005 have been fully considered but they are not persuasive.
13. On page 11-19, Applicant argues in essence:

“In contrast with Blomgren, there is no first pass attempt to process an instruction followed by a second pass in which an emulation instruction actually processed.”

However, Applicant is arguing a feature of the invention not specifically stated in the claim language, which is improper. Claimed subject matter, not the specification, is the measure of invention. Limitations in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Self*, 213 USPQ 1,5 (CCPA 1982); *In re Priest*, 199 USPQ 11,15 (CCPA 1978).

"It is the claims that measure the invention." SRI Int'l v. Matshushita Elec. Corp., 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (en banc).

"The invention disclosed in Hiniker's written description may be outstanding in its field, but the name of the game is the claim." In re Hiniker Co., 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

"[A]s an initial matter, the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." In re Morris, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

"limitations appearing in the specification will not be read into the claims, and ... interpreting what is meant by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper'." Intervet Am., v. Kee-Vet Labs., 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)(citation omitted).

"it is entirely proper to use the specification to interpret what the patentee meant by a word or phrase in the claim, ... this is not to be confused with adding an extraneous limitation appearing in the specification, which is improper. By 'extraneous,' we mean a limitation read into a claim from the specification wholly apart from any need to interpret ... particular words or phrases in the claim." In re Paulsen, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (citation omitted).

In this case, Applicant has not specifically claimed "first pass attempt to process an instruction followed by a second pass in which an emulation instruction actually processed." If applicant would like specific limitations read into the

Art Unit: 2181

claims, then applicant should specifically claim those limitations. Therefore this argument is moot.

14. On page 16, Applicant argues in essence:

"Blomgren's multiplexer does not select between two versions of the instruction as in claim 36, or output either a source/computer instruction or jump instruction as in claims 1, 26, and 37."

However, Blomgren's multiplexer does select between two versions of the instruction as claimed in claim 36. and similarly in claims 1, 26, and 37. Claim 36 claims "selecting between the jump and link instruction and the original instruction based on the result of the determining". The multiplexer of Blomgren selects a decoded instruction from either the RISC, CISC, or emulation decode block based on a mode bit (Figure 2, element 46, column 6, lines 53-56, elements 42 and 38, column 6, lines 28-32, column 7, lines 1-12 and 25-67, column 9, lines 1-32 and 45-54, Very complex instructions that are poorly understood are emulated instead of being directly supported. The multiplexer decides whether to select an original instruction or another emulated version of the instruction.). Therefore this argument is moot.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

16. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 2181

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

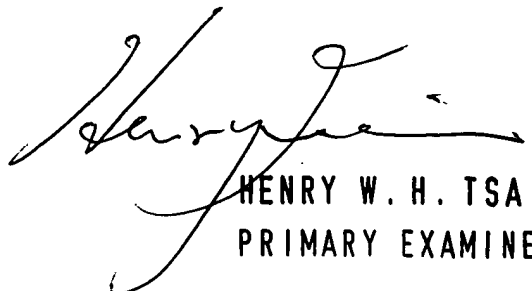
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tonia L. Meonske whose telephone number is (571) 272-4170.

The examiner can normally be reached on Monday-Friday, with every other Friday off.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on (571) 272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tlm

 1/23/16
HENRY W. H. TSAI
PRIMARY EXAMINER